

REMARKS

The present invention relates to a novel protein belonging to the TNF superfamily termed "TRANCE" and nucleic acids encoding the same.

Applicants acknowledge that the Examiner has deemed the application to be in condition for allowance except for the fact that several formal matters should be addressed. The present Amendment serves to address these formal matters.

Applicants appreciate the Examiner's time during a teleconference on October 21, 2005, between the Examiner, Gregory S. Emch, and Applicants' representative, Quang Nguyen (Registration No. 52,066). During that teleconference, it was agreed that the present application was filed on June 4, 2001 as a continuation application of U.S. Application No. 09/210,115.

Priority under 35 U.S.C. § 119(e)

According to the outstanding Office Action, the Examiner contends that the present application has an effective filing date of May 9, 2002 rather than June 4, 2001. Therefore the Examiner asserts that the present application was not co-pending with prior application, U.S. Application No. 09/210,115, on May 9, 2002, because U.S. Application No. 09/210,115 was abandoned on June 5, 2001. Applicants respectfully disagree for the following reasons.

Upon review of the file history, the present application was filed on June 4, 2001 (see the attached courtesy copy of the Transmittal Form), which at the time was co-pending with U.S. Application No. 09/210,115. The Transmittal Form clearly indicates (in Box 18) that the present application is a continuation application of U.S. Application No. 09/210,115 and recites the following:

"For CONTINUATION OR DIVISIONAL APPS only: The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts."

In any event, subsequent to the filing of the continuation application on June 4, 2001, the Patent Office issued a Notice of Omitted Item(s) on March 14, 2002, in view of the fact that page 119 was allegedly omitted. In response to the Notice of Omitted Item(s), previous

counsel submitted a Petition to Request for Inclusion of Omitted Item(s). In response to the petition, the Office of Petitions dismissed the petition and stated that “the application is being returned to the Office of Initial Patent Examination for further processing with a filing date of June 4, 2001.” As such, it appears that the Patent Office acknowledged that the application was filed on June 4, 2001.

The above set of facts were presented to the Examiner in the teleconference on October 21, 2005. The Examiner agreed that the present application was filed on June 4, 2001 as a continuation application of U.S. Application No. 09/210,115. The Examiner indicated that the priority claim to the earlier applications is correct and would be acknowledged following a formal response to the outstanding Office Action.

The Examiner suggested that the specification should be amended to correct the priority claim to the prior applications. The amendment to the specification made herein is consistent with the Examiner’s suggestion. The amendment to the specification does not constitute new matter, as the priority claim was properly claimed on the Application Transmittal Form filed with the present application on June 4, 2001.

Summary

Applicants submit that the present application was co-pending with prior U.S. Application No. 09/210,115 on June 4, 2001. Therefore, the present application properly claims priority to earlier applications.

Respectfully submitted,

Yongwon Choi et al.

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(Date)

By:



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Enclosures: Courtesy copy of the Transmittal Form

